

REMARKS/ARGUMENTS

This Response to the Office Action mailed November 3, 2006 comprises a minor claim amendment, a request for reconsideration of the final rejection, and a request for clarification of the rejections, as described below.

Amendment

Upon careful review of the claims, it was discovered that claim 59 as originally filed lacked a period (".") at the end of the claim. With entry of this amendment, claim 59 is properly punctuated.

Clarification

In the previous Office Action mailed March 21, 2006, claims 34-38 were allowed, and claims 6, 19, and 57 were objected to but indicated as allowable if rewritten into independent form. In the amendment filed June 7, 2006, claims 6, 19, and 57 were rewritten into independent form. Claim 7 depends from claim 6.

In the body of the pending Office Action mailed November 3, 2006, claims 6, 7, 34-38 are indicated as allowed, while claims 19, 34, and 57 are indicated as objected to for depending from a rejected base claim, but would be allowable if rewritten into independent form. Claims 19 and 57, however, were already rewritten into independent form with the June 7th amendment, and claim 34 was previously allowed (and is already independent in its original form).

Therefore, it is believed that claims 19 and 57 should also be indicated as allowed, in addition to claims 6, 7, and 34-38. Applicants respectfully request clarification of the status of claims 19 and 57.

Request for Reconsideration

In the pending Office Action, the Examiner rejected claims 1, 2, 3, 5, 8, 51, 53, 54, 56, 58, and 73-83 as being obvious over Gaffney (U.S. Pat. No. 3,517,871) in view of Ford (U.S. Pat. No. 3,522,752). The remaining pending claims were rejected over Gaffney and Ford and one or more other cited references. The Examiner allowed the claims to a pill cutter having a lid and a blade guard that incorporates a cam. It is submitted that the invention is not limited to

embodiments that incorporate a cam, and it is submitted that the cited references do not support the obviousness rejection. Reconsideration is respectfully requested.

Rejection for Obviousness

As noted in MPEP § 706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success for making the combination. Finally, the prior art references must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. It is submitted that the obviousness rejection of the claims is not supported by the references.

In the previous amendment of June 7, following a telephone interview with the Examiner, applicants amended independent claims 1, 17, 51, 73, and 79 so all incorporate the limitation of a retractable blade guard that moves in direct response to movement of the lid alone. In making the obviousness rejections, the Examiner admits that Gaffney does not show that the movement of the lid alone is directly translated into movement of the blade guard. But the Examiner cited Ford as showing the direct coupling between movement of the lid and movement of the blade guard, stating that "movement of the lid 20 [alone]* is directly translated into movement of the blade guard 21." It is submitted that Ford cannot make up for the deficiencies of Gaffney. Firstly, Ford is directed to a different problem from Gaffney and therefore there is no motivation to combine these references. Secondly, Ford cannot be successfully combined with Gaffney. Lastly, no combination of Gaffney and Ford could provide the claimed invention.

* In the Office Action, the Examiner substituted "along" in place of "alone" when comparing the references to the claim language. See Paragraph 3(i) at Page 3 of the Office Action. The claims, however, do not recite that "movement of the lid *along* is directly translated into movement of the blade guard" but rather recite movement of the lid *alone*. It is submitted that this discrepancy further supports this request for reconsideration.

1. No Motivation to Combine

Gaffney shows a tablet cutting device in which a lid is closed over a tablet that is resiliently held in place so the tablet is cut into two halves without crushing the tablet (see column 1, lines 49-57). A pair of resilient pads 31, 32 (Fig. 4) or 61, 62 (Fig. 8) hold the tablet in place during cutting. In contrast, Ford is directed to the problem of holding a stack of sheets in place during a paper trimming action with a rotating blade (col. 1, lines 25-40). Ford provides a paper trimmer with a flat work platform 1 and an L-shaped cover 21 that is biased toward the work platform by a spring 23. A lever 20 rotates the cutting blade 14. Ford's cover 21 is in no way coupled to the cutting blade 14. Rather, the spring 23 biases the cover 21 against the work platform to hold the sheets in place (col. 2, lines 42-43). It is submitted that there would be no motivation to combine Gaffney's tablet cutting device with Ford's paper trimmer.

2. No Success for Combining

The tablet cutter of Gaffney could not be successfully combined with the paper trimmer of Ford to provide a working pill splitter. Gaffney resiliently holds a tablet in a receptacle that is bisected by a razor blade coupled to a lid to cut the tablet without crushing (col. 1, lines 58-63). Ford clamps a stack of papers against a platform with a spring-biased cover (col. 2, lines 43-44) so the papers can be cut by a rotating cylindrical blade (col. 2, lines 9-19). Ford's cover 21 is used to help clamp papers in place during cutting. If Ford's cover experienced any movement during blade cutting, an undesirable inaccurate trim would result. Thus, any attempted combination of Gaffney with Ford would produce an inoperable device.

3. Cannot Produce the Claimed Invention

Even if the Gaffney tablet cutter and the Ford paper cutter could somehow be combined together, it is asserted that the combination could not provide the claimed invention. Gaffney's blade guard comprises a pair of resilient foam pads that are moved by the tablet itself pressing against the pads. Thus, as recognized by the Examiner, Gaffney's blade guard is not configured so that movement of the lid alone is directly translated into movement of the blade guard. Ford, however, does not move his cover 21 during the cutting operation. Rather, a steel spring 23 biases the Plexiglas cover 21 against the flat work platform 1. A lever 20 is used to

rotate the cutting blade 14 against the platform and cut the paper. There is no connection between moving the lever 20 to cut the paper and the biased cover 21 that holds the paper in place during cutting. Ford's cover does not move during cutting, and therefore no combination of Gaffney and Ford could result in a blade guard that is moved in response to movement of the lid alone.

The rejected claims recite that moving the lid alone causes movement of the blade guard. Yet Gaffney does not move his blade guard in response to movement of the lid alone (the tablet moves the guard), and Ford does not move his lid (he moves his lever). Therefore, it is submitted that the proposed combination of Gaffney and Ford does not render obvious claims 1, 2, 3, 5, 8, 73-83.

It is submitted that the other cited references do not make up for the deficiencies of Gaffney and Ford. The cited patents were asserted for sub-structures that do not make up for the deficiencies of Gaffney and Ford, and include devices that either are pill splitters with no blade guard or are not even pill splitters. Therefore, the proposed combinations, even if successfully combined and even if suggested by the art, would not provide all the claimed features. Thus, the rejected claims are not rendered obvious by the proposed combinations.

Secondary References

The cited secondary references to Reitano, Dienst, Buckley, Bendickson, and Stevens do not include blade guards or are not even pill splitters. Therefore, none of them can possibly make up for the deficiencies of Gaffney and Ford in that none of them can provide a blade guard that moves in response to movement of the lid or the blade itself. Thus, claims 4, 9, 17, 18, 20, 21, 22, 23, 24, 25-27, 28, 29, 52, 55, and 59 are not rendered obvious by the art of record, but are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants assert that all claims now pending in this Application are in condition for allowance. The allowable claims therefore are submitted to comprise claims 1-9, 17-29, 34-38, 51-59, 73-83. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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Amdt. dated November 28, 2006
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3724

PATENT

If the Examiner believes a further telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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